



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/673,913 | 09/29/2003 | Werner Hiereth | 10286.105001 | 7347 |

20786 7590 08/22/2006

KING & SPALDING LLP
1180 PEACHTREE STREET
ATLANTA, GA 30309

| |
|----------|
| EXAMINER |
|----------|

SHAY, DAVID M

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3735

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,913

Applicant(s)

HIERETH ET AL.

Examiner

david shay

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 3, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7,10,12,13,15,16,18,21,23-41 and 43-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7,10,12,13,15,16,18,21,23-41 and 43-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 3, 2006 has been entered.

Applicant's arguments have been fully considered, but are not convincing. Applicant has no antecedent basis for the term "new data set" and had demonstrated no particular meaning for this term in the art. Further, it is noted that Harman et al teaches the use of an EEROM and encryption, which is intended to preserve data and prevent tampering, and that Pacala et al teach the use of redundant data storage including the use of ROMs, which would also prevent data loss and tampering.

The amendment filed October 3, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "transponder is configured to store the transmitted specific data as a new data set and to apply encryption to the new data set, thus preventing any stored specific data from being deleted, overwritten, or modified".

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 34-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

Art Unit: 3735

art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure is silent on the “transponder is configured to store the transmitted specific data as a new data set and to apply encryption to the new data set, thus preventing any stored specific data from being deleted, overwritten, or modified”, specifically, there is no showing how simple encryption alone and prevent, e.g. erasure of the data, further there is no discussion of storing the data as “a new data set”, whatever this phrase is construed to encompass.

Claims 34-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 34 is indefinite as the exact meaning of the term “a new data set” is unclear.

Claims 1, 2, 5, 7, 10, 12, 13, 15, 16, 18, 21, 23-26, 29-37, 40, 41, and 43-47 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Harman et al.

See Figures 1, 2, 3, and 8, especially Figure 8D, element 132 et seq. and column 4, line 35 to column 8, line 60, wherein, applicant discloses no particular encryption protocol which will prevent erasure, modification or overwriting of the data, therefore any encryption protocol is considered to confer these properties upon the data encrypted therewith and wherein the data recorded at one particular time is considered a “data set” and the data recorded at a subsequent time is considered another “data set”.

Claims 1, 2, 5, 7, 10, 12, 15, 16, 31-33, 41 and 45-47 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pacala et al.

See Figures 2, 3, 18, 24, 25, 32, 35, and 38 and pages 15 to 21.

Claims 1, 2, 5, 7, 10, 12, 13, 15, 16, 18, 21, 23-41 and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harman et al in combination with Pacala et al, and the admitted prior art of gluing and welding the transponder to the fiber. Harman et al teach a device as claimed except the transponder being glued or welded into the connector device, the use of a write once device, and displaying an alert. Pacala et al teach a device as claimed except the transponder being glued or welded into the connector device. It would have been obvious to the artisan of ordinary skill to record the data of Harman et al in the device of Pacala et al, since these are highly useful for assuring proper functioning of the fiber, as taught by Harman et al, or to display alerts, and employ ROMs for data recordation, as taught by Pacala et al in the device of Harman et al, since this keeps the surgeon apprised of the useful life of the device; and in either case to employ a write once transponder, which must be known to those of ordinary skill in the art, as applicant has provided no details whatsoever of the structure or construction of such a device, in place of or in addition to the ROM of Pacala et al or the EEPROM of Harman et al, since this would prevent the data from being lost or tampered with, and in either case to glue or weld the transponder to the coupler, since there are notorious way of securing parts together in the art, official notice of which has already been taken, thus producing a device such as claimed.

Applicant's arguments with respect to claims 1, 2, 5, 7, 10, 12, 13, 15, 16, 18, 21, 23-41 and 43-47 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330